

REMARKS/ARGUMENTS

Claims 24, 28, 29, and 32-34 are pending and were examined. Reexamination and reconsideration of the claims, without amendment, are requested in view of the following remarks.

The Examiner relies on U.S. Patent No. 4,591,341 to Andrews in rejecting all examined claims for obviousness. Applicants respectfully disagree.

Independent claims 24 and 32, the only pending independent claims, set forth a removable elastic positioning appliance having a cavity for receiving teeth. The cavity has first and second hedges with "at least one protrusion disposed along the first edge of the hollow cavity and at least one additional protrusion disposed along the second edge of the hollow cavity. The protrusions assist in holding the cavity in place by contacting a plurality of teeth in a particular manner. That is, the protrusion comprises "a continuous protrusion which is configured to fit in the undercut of the plurality of teeth and to contact said plurality of teeth along the length of the gingival margin and interdental areas between said teeth." This manner of engaging the teeth is illustrated, for example, in Figs. 15A and 15B.

The apparatus described in Andrews '341 is quite distinct. The positioner of Andrews has a plurality of suction devices 14, 16, and 20 which are positioned along the three walls of the molded depressions within the positioner. While the suction devices do protrude, the protruding structure is not continuous and is incapable of engaging the undercut of the teeth along the gingival margin and interdental areas between teeth, as required by the claims herein. While the suction devices 14, 16, and 20 have a continuous backing, the continuous backing is embedded in the wall of the positioner and does not protrude. Moreover, the individual suction components of the devices are intended to engage the individual teeth in order to hold the positioner in place. Aligning these suction members to engage teeth at the gingival margin or at the interdental areas between the teeth will prevent the suction elements from adhering to the teeth, as is the clear intent and requirement of the Andrews '341 patent.

The Examiner concedes that Andrews fails to disclose the protrusion "being positioned along the edge of the positioner," but argues that it would have been obvious "to

modify Andrews by changing the position of the protrusion as desired based on individual needs.” Such argument is not persuasive. As noted above, if the suction elements of Andrews were moved along they edges of the positioner, they would engage the gingival margin and interdental areas between said teeth, and the suction elements would be incapable of adhering to the teeth and the device of Andrews would be dysfunctional. As is well known to the Examiner, combinations or modifications of the art which render the art inoperable for its intended purpose are not considered obvious. See, e.g., *MPEP* 2143.01(V).

CONCLUSION

For these reasons, Applicants believe that claims 24, 28, 29, and 30-34 clearly distinguish the teachings of Andrews and request that the application be passed to issue at an early date.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at 650-326-2400.

Respectfully submitted,

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